

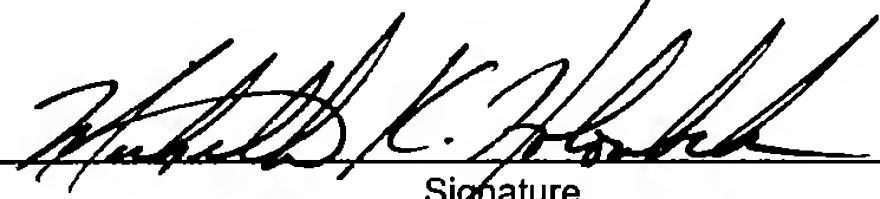
Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

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| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) 1487.0320001 | |
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____ | Application Number 10/625,701 | Filed July 24, 2003 | |
| | First Named Inventor Colin Whitehurst | | |
| | Art Unit 3739 | Examiner Johnson III, Henry M. | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between;"><div style="width: 45%;"><p><input type="checkbox"/> applicant/inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input type="checkbox"/> attorney or agent of record. Registration number _____</p><p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 <u>54,179</u></p></div><div style="width: 50%; text-align: center;"> Signature <u>Michelle K. Holoubek</u> Typed or printed name <u>(202) 371-2600</u> Telephone number <u>March 7, 2007</u> Date</div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | |
| <input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted. | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Colin Whitehurst

Appl. No.: 10/625,701

Filed: July 24, 2003

For: **Therapeutic Light Source and Method**

Confirmation No.: 9946

Art Unit: 3739

Examiner: Johnson III, Henry M.

Atty. Docket: 1487.0320001

Arguments to Accompany the Pre-Appeal Brief Request for Review

Mail Stop AF

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby submits the following Arguments, in five (5) or less total pages, as attachment to the Pre-Appeal Brief Request for Review (Form PTO/SB/33). A Notice of Appeal is concurrently filed.

Arguments

Applicant's arguments in the Amendment and Reply under 37 C.F.R. § 1.111 filed on October 6, 2006, were not properly considered or responded to by the Examiner in the final Office Action mailed December 7, 2006 (hereinafter the Office Action). The Examiner's response was legally and factually deficient because the Examiner failed to show where the combination of McDaniel and Bourn teaches or suggests a light source for therapy and/or diagnosis having "one or more fans for cooling the first, second and/or third rigid arrays," as recited in independent claim 9, or a light source for therapy and/or diagnosis, wherein "each said array includes means for cooling the diodes by forced air convection," as recited in independent claim 62.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." M.P.E.P. § 2143.03, citing *In re Royka*, 490 F.2d 981 (CCPA 1974).

The Examiner has rejected claims 9, 62, and 64-66 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Pat. No. 6,663,659 to McDaniel ("McDaniel") in view of U.S. Pat. No. 6,290,382 to Bourn *et al.* ("Bourn"). Applicants respectfully assert that there is no motivation to combine McDaniel and Bourn to produce a therapeutic light source according to the claimed invention.

Claim 9 recites, among other things, "one or more fans for cooling the first, second and/or third rigid arrays." Although McDaniel states that cooling devices may be used (*see*, McDaniel, col. 18, lines 2-3), the only description given for the type of cooling device that may be used indicates that it is used not only for cooling, but also to produce certain optical effects. Specifically, "cooling may be accomplished by various methods wherein a cooling apparatus utilizes a sealed chamber and liquid coolant which also function to match the refractive index or to produce diffusion and thus illustrates an example of one way to achieve dual purpose with cooling agents" (col. 6, line 66 - col. 7, line 4).

Furthermore, the provisional application no. 60/176,175, filed January 13, 2000, to which McDaniel claims priority, actually teaches away from the use of a non-liquid cooling system when it states that there may be harm to the light source unless it is cooled with a special cooling system. Specifically, "cooling of the optoelectronic devices themselves may be desirable in order to allow them to be operated at higher voltage...which while producing greater energy output, may be damaging to the devices themselves unless special cooling is utilized. One option with such cooling is to use a refractive index matching fluid as the cooling agent." (*See*, Appl. No. 60/176,175, pg. 8).

According to M.P.E.P. § 2143.01(IV):

"a statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references."

Additionally, M.P.E.P. § 2143.01(IV) cites *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308 (Fed. Cir. 1999) as indicating that "the level of skill in the art cannot be relied upon to provide the suggestion to combine references."

Nonetheless, the Examiner asserts that a skilled artisan working with semiconductor devices would, in general, be concerned with heat generated by a device such as that of McDaniel and look to previous cooling methods, such as those described in Bourn, for an appropriate cooling method. *See*, Office Action, pp. 2-3. Applicant respectfully disagrees with the Examiner's characterization of such a scenario. If a skilled artisan were concerned with heat buildup while using the device of McDaniel, the artisan would need to look no further than McDaniel for a solution to this problem. McDaniel recognizes that cooling systems may be used, and provides a cooling system specific to the device. *See*, e.g., McDaniel, Fig. 37 and col. 6, line 66 - col. 7, line 4. The McDaniel provisional even takes the further step of teaching away from using any other type of cooling system. Therefore, the Examiner's reasoning that a skilled artisan would look to an outside reference for a cooling solution, when a cooling solution is already provided in McDaniel, is unsound.

Additionally, even if a skilled artisan was motivated to look further than McDaniel for a cooling solution (which Applicants do not concede), the skilled artisan would not have been motivated to combine McDaniel with Bourn, because Bourn is nonanalogous art. Bourn is directed to a machine vision system that uses LEDs input into a fiber optic bundle. Although these LEDs are cooled with a heatsink and fan, such a cooling system is ancillary to the

overarching invention of Bourn, which is a fiber optic illuminator for a machine vision system. It would not have been obvious for one of skill in the therapeutic light art to look to the machine vision art to produce a therapeutic device.

For at least these reasons, Applicant respectfully submits that one of skill in the art would not be motivated to combine McDaniel and Bourn to produce a light source for therapy and/or diagnosis having "one or more fans for cooling the first, second, and/or third rigid arrays," as recited in claim 9.

Claim 62 recites a light source for therapy and/or diagnosis, wherein "each said array includes means for cooling the diodes by forced air convection." Claims 64-66 depend from claim 62, and thus incorporate the features of claim 62. For at least the reasons discussed with respect to claim 9, McDaniel and Bourn cannot be combined to produce a light source including means for cooling the diodes by forced air convection, as recited in claim 62.

Claims 10 and 62-63 stand rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over McDaniel in view of Bourn, and further in view of U.S. Pat. No. 6,450,941 to Larsen ("Larsen"). Applicants respectfully traverse.

Claim 10 depends from claim 9, and is thus patentable over the combination of McDaniel and Bourn for at least the reasons discussed with respect to claim 9, and further in view of its own respective features. Claim 63 depends from claim 62. As discussed above, claim 62 is also patentable over the combination of McDaniel and Bourn. The addition of Larsen does not cure the impropriety of the combination of McDaniel and Bourn, as Larsen does not discuss any type of cooling system. Therefore, claims 10, 62, and 63 are patentable over the combination of McDaniel, Bourn, and Larsen for at least the reasons discussed with respect to claim 9, and further in view of their own respective features.

The Examiner has failed to establish a *prima facie* case of obviousness for at least the reason that McDaniel, Bourn, and Larson, alone or in any rational combination, fail to teach or

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suggest a light source for therapy and/or diagnosis having "one or more fans for cooling the first, second and/or third rigid arrays," as recited in independent claim 9, or a light source for therapy and/or diagnosis, wherein "each said array includes means for cooling the diodes by forced air convection," as recited in independent claim 62. Thus, Applicants assert that the Examiner's continued reliance upon the combination of McDaniel and Bourn in supporting an obviousness rejection of claims 9, 62, and 64-66 and the combination of McDaniel, Bourn, and Larsen in supporting an obviousness rejection of claims 10, 62, and 63 is legally and factually unfounded. Applicants respectfully request reconsideration and withdrawal of the rejections of claims 9-10 and 62-66.

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: March 7, 2007

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